

REMARKS

Applicants acknowledge receipt of the Examiner's Office Action dated June 6, 2008. Claims 33-38 are rejected under 35 USC § 101 because the claimed invention is directed to non-statutory subject matter. The Office Action maintains the written description and enablement rejections set forth in the Final Office Action generated January 22, 2008. Claims 28-42 were rejected as failing to comply with the written description requirement of 35 USC § 112, first paragraph. Claims 28-42 were also rejected as failing to comply with the enablement requirement of 35 USC § 112, first paragraph. In light of the following remarks, Applicants request the Examiner's reconsideration and re-examination of all pending claims.

Claims 33-38 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicants have amended the specification by removing language that defines "computer readable medium" as including communications media conveying signals in coding their instructions. In light of this amendment, Applicants assert all claims are in compliance with 35 U.S.C. § 101. The office action maintains its prior written description rejection of all claims. Previously, Applicants pointed to Appendix B and Appendix C of www.uspto.gov/web/menu/written.pdf in support of their argument that the claims are in compliance with the written description requirement. The most recent office action found Applicant's prior argument unpersuasive because appendices B and C are both directed to determining whether a later filed continuation application is entitled to the priority date of an earlier filed patent application. Applicants agree that Appendices B and C are both used to determine whether a later filed application is entitled to a priority date of an earlier filed application. Additionally, Applicants argue that Appendices B and C can be used to determine compliance with the

written description requirement. See, e.g., the last box of Appendix C. The office action also asserts that each claim is not commensurate in scope with the combined disclosure of the priority application and the original claims. Applicants object to us of this inclusive, two-part test of the written description requirement. Any argument that a claim of a continuation application must be commensurate in scope with the combined disclosure of the priority application and the original claims would lead to the illogical conclusion that a continuation application cannot be filed with claims that are narrower in scope than the original claims of the parent application. Applicants recognize that both Appendix B and Appendix C include a decision box that reads, “Is the claim narrower in scope than the specification in original claims?” However, Applicants assert this decision box was added to the flow in order to remind Examiners that claims are considered part of the specification. In the undersigned attorney’s experience, many Examiners (other than the Examiner of the instant application) often reject original claims as being in violation of the written description requirement, notwithstanding the provisions set forth in MPEP 2163.06(III). The undersigned believes that the box in question of Appendix B (and Appendix C) was designed to clear any confusion on this issue, and not to require claims of a continuation application to be commensurate in scope with the claims of the parent application.

Further in rejecting the claims as failing to comply with the written description requirement, the office action on page 8 indicates that limitations of the pending claims are not expressly, inherently, or implicitly supported. Applicants respectfully traverse this assertion. The focus of the written description rejection is the claim requirement of transferring two or more data elements at a time. Applicants previously asserted and continue to assert the specification provides support for this limitation. For example, support can be found on page 26, lines 15-24. At the very least, Applicants request a

more detailed explanation of why limitations of the claims are not expressly, inherently or implicitly supported than is provided in paragraph 4, page 8 of the office action.

As noted above, all claims stand rejected as failing to comply with the enablement requirement of 35 U.S.C. § 112, first paragraph. Applicants have amended the claims by adding limitations thereto. For example, independent claim 28 now recites “wherein the data width of data elements is less than a width of the memory bus” and “packing two or more of the data elements of the plurality into a data block” and “transferring the data block . . . so that the two or more data elements are transferred at a time.” Support for these amendments can be found, for example, on page 26, line 8 – page 27, line 10, which includes that it is “possible that memory controller 222 can pack two or more data elements into a larger block which would use memory bus 224 more efficiently.”

To meet an enablement rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. § 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. MPEP 2164.04. Applicants have amended the claims to include limitations which correspond in scope to those used in the specification. Accordingly Applicants assert that the claims are in compliance with 35 U.S.C. § 112, first paragraph.

CONCLUSION

In view of the amendments and remarks set forth herein, the application and the claims therein are believed to be in condition for allowance without any further examination and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is invited to telephone the undersigned.

If any extensions of time under 37 C.F.R. § 1.136(a) are required in order for this submission to be considered timely, Applicant hereby petitions for such extensions. Applicant also hereby authorizes that any fees due for such extensions or any other fee associated with this submission, as specified in 37 C.F.R. § 1.16 or § 1.17, be charged to Deposit Account 502306.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'E. Stephenson', with a long horizontal line extending to the right.

Eric A. Stephenson
Attorney for Applicants
Reg. No. 38,321
Telephone: (512) 439-5093
Facsimile: (512) 439-5099